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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,102	07/17/2000	NICHOLAS THOMAS	PA9720	9263
22840	7590	10/25/2004	EXAMINER	
AMERSHAM BIOSCIENCES PATENT DEPARTMENT 800 CENTENNIAL AVENUE PISCATAWAY, NJ 08855			GABEL, GAILENE	
			ART UNIT	PAPER NUMBER
			1641	

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/555,102

Applicant(s)

THOMAS, NICHOLAS

Examiner

Gailene R. Gabel

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 22 June 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.Claim(s) objected to: NONE.Claim(s) rejected: 1,3,5-9 and 12-18.Claim(s) withdrawn from consideration: NONE.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

SGabel
10/18/04

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ADVISORY ACTION

Interview Summary

1. In an interview between Applicant's representative, Steve Ryan, and Long V. Le and Gailene R. Gabel on 10/5/04, it was agreed upon that Applicant's amendment filed 6/22/04 which amends claims 1 and 12 to recite that "the N samples have a single compound to be tested" does not raise new issues that require further consideration and search, for reasons that the language has been previously presented in the preamble and that it does not provide substantial change to the body of the claim. Accordingly, the Advisory Action mailed to Applicant on 8/5/04 is being vacated.

Amendment Entry

2. Applicant's amendment and response filed 6/22/04 is acknowledged and has been entered. Claims 1, 6, and 12 have been amended. Accordingly, claims 1, 3, 5-9, and 12-18 are pending and are under examination.

Rejections Withdrawn

Claim Rejections - 35 USC § 112

3. In light of Applicant's amendment and arguments, the rejection of claims 1, 3, 5-9, and 12-18 under 35 U.S.C. 112, second paragraph, is hereby, withdrawn.

Rejections Maintained

Claim Rejections - 35 USC § 103

4. Claims 1, 3, 5-7, 9, 12-16, and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chandler et al. (US 5,981,180) in view of Yamashita et al. (US 6,210,900) for reasons of record.
5. Claims 8 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chandler et al. (US 5,981,180) in view of Yamashita et al. (US 6,210,900) and in further view of Mandecki (US 5,641,634) for reasons of record.

Response to Arguments

6. Applicant's arguments filed 6/22/04 have been fully considered but they are not persuasive.

A) Applicant argues that neither Chandler nor Yamashita teaches the addition of multiple samples containing a single compound to be tested, as claimed.

In response, the combined teaching of Chandler with Yamashita appears to read on the claimed invention since the claimed N samples are not recited as N different samples.

B) Applicant argues that Yamashita does not teach the use of a method with pre-existing compounds that are not coupled to beads and consequently, does not disclose the dispensing of "samples each containing a single compound to be tested".

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In response to applicant's argument that Yamashita only teaches use of a method with pre-existing compounds that are coupled to beads, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, the rejection is based on the combined teaching of Chandler with Yamashita. Chandler discloses multiplexed analysis of samples each containing test compounds (analytes) using populations of carrier beads labeled with an appropriate reactant. The classification parameter for each population is known and therefore the identity of each population can be verified using flow cytometry. Each bead population is coated with different reactants so as to bind or react and detect different compounds. Yamashita is incorporated with Chandler only for the teaching of identifying test compounds using populations of carrier beads having reagent bound thereto which are placed into N reaction vessels. Yamashita specifically teaches dispensing an entirety of a population of beads into separate reaction vessels or wells of a microtiter plate; beads usually are divided into populations of 1000 or more. Thereafter, appropriate reagents are added to each individual reaction vessel for reaction or assay to take place. After washing, the populations of beads are combined into a single mixture and subjected to flow cytometry for sorting. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to have combined the reaction samples in the method of Chandler into separated reaction vessels for individual assay and subsequently into a single mixture for flow cytometric

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analysis as in the method taught by Yamashita because Yamashita specifically taught high throughput advantage in combining various reacted samples into a single mixture for flow cytometric analysis which allows for sorting, identification, and analysis based on their characteristic parameters acquired after exposure with corresponding individual compounds.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gailene R. Gabel whose telephone number is (703) 305-0807. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0169.

Gailene R. Gabel
Patent Examiner
Art Unit 1641
October 18, 2004

gg

Christopher L. Chin

CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800/1641
10/22/04